



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,228	11/22/1999	GENE PHILLIP DIPOTO	0231/0314-00	3547
7590	08/01/2005		EXAMINER	
JOEL R PETROW ESQ CHIEF PATENT COUNSEL SMITH & NEPHEW NORTH AMERICA 1450 BROOKS ROAD MEMPHIS, TN 38116			JACKSON, GARY	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 08/01/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/447,228	DIPOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gary Jackson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 28 February 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-19, 21-71, 73-99 and 102-110 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 89-93 is/are allowed.  
 6) Claim(s) 1-19, 21-71, 73-88, 94-99 102-110 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**GARY JACKSON**  
**PRIMARY EXAMINER**  
**GROUP 3300**

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

This action is responsive to the Remarks filed April 28, 2005. Applicants' responded to the rejection of claims 1-19, 21-71, 73-99 and 102-110 under 35 USC 251 as being improper recapture of broaden claimed subject matter surrender in the applications (08/091,092 and 08/509,966) for the patent upon which the present reissue is based. Claims 20, 72, 100 and 101 have been cancelled; claims 1-19, 21-71, 73-99 and 102-110 are pending.

Applicants contend independent claims 89-93 should not be subject to the recapture rule since these claims are directed to method claims and since methods were not presented in the above applications which matured into patent 5,690,676. Therefore, the rejection of claims 89-93 under 35 USC 251 has been withdrawn.

The applicant further contend that the examiner fail to address the third element of *Pannu*, i.e. whether the claims were materially narrowed in other aspects to avoid the recapture rule in view of the above applications. It is argued that claims 19, 36, 52, 71, 77, 88, 94-98, 102, 108, 109 and 110 have been materially narrowed in other aspects relative to the claims of the '676 patent and therefore are not subject to the recapture rule.

Applicants presented several examples of the narrowing limitations for each of the rejected claims, i.e., claims 19 limits the anchor to "rigid body defining a generally transverse, circumferentially bounded opening through said body for receiving the suture" and limits the "rigid body" to having "a non-helically extending exterior

Art Unit: 3731

enlargement [that] comprises a circumferential ridge." The example is exemplary of the limitations to claims 36, 52, 71, 77, 88, 94-98, 102, 108, 109 and 110.

The examiner respectfully traverse the arguments concerning non-showing of Pannu's third test for recapture, namely: whether, the reissued claims were materially narrowed in other aspects to avoid recapture rule. This analysis is clearly set forth in the office action mailed August 27, 2004, on page 3, paragraphs 1-3. Applicants' attention is directed to the third element of the general claim limitation recited on page 3 representing the claims in the '092 and '966 applications. This limitation is considered the surrender-generating limitation. Therefore the claims in the present application are broader in relation to this aspect. Although they are narrower in another aspect (claim 19 above), but it is unrelated to the surrender-generating limitation; therefore the recapture rule bars the claims.

***Allowable Subject Matter***

Claims 89-93 are allowable over the art of record.

The examiner believes this rejection is proper and therefore made final.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3731

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Antoine Nguyen can be reached on (571) 272-4693. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson  
Primary Examiner  
Art Unit 3731



gj  
July 25, 2005